UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,696	09/25/2003	Takahiro Goto	Q77306	4442

23373 7590 02/23/2005

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
GILLIAM, BARBARA LEE	
ART UNIT	**PAPER NUMBER**
1752	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/669,696	GOTO, TAKAHIRO	
	Examiner	Art Unit	
	Barbara L. Gilliam	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/25/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claims

2. Claims 1-20 are present.

3. Claims 9 and 10 further limit the ester and amide of claim 8 respectively without requiring the choice of the ester over the amide or vice versa.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-12, 17-19 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-9, 12-21 and 24 of U.S. Patent No. US 6,838,222 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because Aoshima et al. claim a

photopolymerizable composition comprising a polymerizable compound, a radical polymerization initiator having a maximum absorption wavelength of no greater than 400 nm, a binder polymer and a compound capable of generating heat by infrared exposure. It would have been obvious to one of ordinary skill in the art to make a photopolymerizable composition comprising a polymerizable compound, a radical polymerization initiator having a maximum absorption wavelength of no greater than 400 nm, a binder polymer and a compound capable of generating heat by infrared exposure with reasonable expectation of obtaining an infrared absorbing composition. Aoshima et al. do not claim the acid value of a film produced from the photopolymerizable composition however the Examiner asserts that the photopolymerizable composition of Aoshima et al. is expected to form a film having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

6. Claims 1-7, 11-14, 16 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-8 and 10 of copending Application No. US 10/900,168 (US 2005/0026082 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because Shimada claim a polymerizable composition comprising a dye that has an absorption at a range of 700 to 1200 nm such as a cyanine dye, a radical polymerization

initiator, a compound having an ethylenically unsaturated bond and a binder polymer wherein the binder polymer contains a structural unit represented by formula (I). It would have been obvious to one of ordinary skill in the art to make a polymerizable composition comprising a dye that has an absorption at a range of 700 to 1200 nm such as a cyanine dye, a radical polymerization initiator, a compound having an ethylenically unsaturated bond and a binder polymer wherein the binder polymer contains a structural unit represented by formula (I) with reasonable expectation of obtaining an infrared absorbing composition. Shimada does not claim the acid value of a film produced from the polymerizable composition however the Examiner asserts that the polymerizable composition of Shimada is expected to form a film having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-5, 7, 12, 17-18, 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 13 of copending Application No. 10/781,645 (US 2004/0244619 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because Goto claims a planographic printing plate precursor comprising on a substrate, a photosensitive layer containing an infrared absorbing agent, a sulfonium salt

polymerization initiator, a polymerizable compound and a binder polymer wherein the binder polymer has a repeating unit represented by general formula (i). It would have been obvious to make the printing plate precursor of Goto with reasonable expectation of obtaining a precursor that is sensitive to infrared radiation. Goto does not claim the acid value of a film produced from the photosensitive composition however the Examiner asserts that the photosensitive composition of Goto is expected to form a film having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-5, 7, 12, 14, 16, 17-18, 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9-15, of copending Application No. 10/756, 679 (US 2004/0223042 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because Goto claims an image forming method comprising exposing an image forming material having a photosensitive layer comprising an infrared absorbing agent, a polymerization initiator, a polymerizable compound and a binder polymer having a repeating unit represented by formula (I) on a substrate to light having a wavelength in the range of 750 nm to 1400 nm. From the method claimed by Goto, it

would have been obvious to one of ordinary skill in the art to make a photosensitive composition comprising an infrared absorbing agent, a polymerization initiator, a polymerizable compound binder polymer having a repeating unit represented by formula (I) with reasonable expectation of obtaining a composition that is imageable via infrared radiation in the range of 750 nm to 1400 nm. Goto does not claim the acid value of a film produced from the photosensitive composition however the Examiner asserts that the photosensitive composition of Goto is expected to form a film having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1-5, 7, 12-14, 16-18 and 20 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/738,305 (US 2004/0137369 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because Shimada claim a polymerizable composition comprising a binder polymer represented by formula (I), a compound having a polymerizable unsaturated group, a compound which has a triarylsulfonium salt structure and a compound having an absorption maximum at 700 to 1200 nm, represented by formula (a). It would have

been obvious to make the composition of Shimada with reasonable expectation of obtaining a composition that is imageable using radiation having a wavelength of 700 to 1200 nm. Shimada does not claim the acid value of a film produced from the polymerizable composition however the Examiner asserts that the polymerizable composition of Shimada is expected to form a film having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-5, 12, 14, 16-18 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/671,776 (US 2004/0131971 A1). Although the conflicting claims 3, 5, 7-9, 11, 15-17 and 22 are not identical, they are not patentably distinct from each other because Sugasaki et al. claim a planographic printing plate precursor comprising a two-layer structure including a second layer comprising a binder polymer represented by formula (I), a polymerization initiator, a polymerizable compound and an IR absorber. It would have been obvious to make composition consistent with the second layer of the two-layer structure claimed by Sugasaki et al. with reasonable expectation of obtaining a composition imageable via infrared radiation. Sugasaki et al. do not claim the acid value of the layer produced from the

composition however the Examiner asserts that the composition of Sugasaki et al. is expected to form a layer having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-5, 11-12, 14-20 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/673,332 (US 2004/0072101 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to make a polymerizable composition comprising a binder polymer having a repeating unit represented by formula (I), an infrared absorbent, a polymerization initiator and a polymerizable compound based on the claims of Sugasaki et al. Sugasaki et al. do not claim the acid value of a film produced from the polymerizable composition however the Examiner asserts that the polymerizable composition of Sugasaki et al. is expected to form a film having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually

exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-5, 12-14, 16-18 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1, 5-9, 14-17 and 20 of copending Application No. 10/782,852 A1 (US 2004/0175648 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to make photosensitive composition comprising an infrared absorbing agent, a sulfonium salt polymerization initiator, a polymerizable compound a binder polymer and a compound having a weight average molecular weight of 3000 or less and having at least one carboxylic acid group a based on the claims of Goto. Goto does not claim the acid value of a film produced from the photosensitive composition however the Examiner asserts that the photosensitive composition of Goto is expected to form a film having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-5, 7-10, 12-14, 16-18 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 and 18of copending Application No. 10/781,922 (US 2004/0170922 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to make photosensitive composition comprising an infrared absorbing agent, a sulfonium salt polymerization initiator, a polymerizable compound having a urethane skeleton and at least one ethylenically unsaturated bond and a binder polymer having a repeating unit represented by formula (i) based on the claims of Goto. Goto does not claim the acid value of a film produced from the photosensitive composition however the Examiner asserts that the photosensitive composition of Goto is expected to form a film having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-15, 17-19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Aoshima (EP 1 096 315 A1).

a. The negative-type image recording material of Aoshima meets the present limitations for the infrared photosensitive composition. Specifically the recording material of Aoshima comprises an infrared absorbent, an onium salt, a radical polymerizable compound and a binder polymer (abstract). The infrared absorbent is a cyanine dye [0017]-[0039], the onium salt preferably has a maximum absorption not longer than 400 nm [0040]-[0045], the radical polymerizing compound has at least one ethylenically unsaturated double bond such as acrylic acid esters [0047]-[0062], and the binder polymer is preferably a linear organic polymer such as (meth)acrylic resins having a benzyl group or an allyl group and a carboxyl group at the side chain or other water soluble linear organic polymers [0063]-[0071]. Aoshima does not teach the acid value of a film produced from the negative-type recording material however the Examiner asserts that the recording material of Aoshima is expected to form a film having an acid value consistent with the film formed from the presently claimed infrared photosensitive composition because the compositions have the same chemical components. "Products of identical chemical composition can not have mutually

exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). MPEP 2112.01.; I. II.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In US 3,930,865, Faust et al. teach a photopolymerizable copying composition comprising at least one polymerizable compound, at least one photo-initiator and at least one copolymer (abstract).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
February 21, 2005